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10/570,056

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Daniel Jeremy Craven

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PARFOMAK, ANDREW N.  
NORRIS MCLAUGHLIN & MARCUS PA  
875 THIRD AVE, 8TH FLOOR  
NEW YORK, NY 10022

EXAMINER

BROWN, COURTNEY A

ART UNIT

PAPER NUMBER

1617

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/570,056	<b>Applicant(s)</b> CRAVEN ET AL.	
	<b>Examiner</b> COURTNEY BROWN	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 16-18,22,24-26,46 and 47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15,19-21,23,27-45 and 48-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/8/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/ Restriction*

The Examiner acknowledges receipt of Applicant's response to the restriction requirement filed on December 1, 2010. Applicant elected with traverse: **chlorpyrifos** as the insecticide (claims 13-18); **honey** as the attractant (claims 20-27) and the application method wherein the insecticidal composition is **applied to the hard surface as a line of material by drawing the stick along the hard surface** (claims 44-47).

Applicant traversed on the grounds that a search of claim one, which had not been indicated as being subject to an election species requirement and/or a restriction requirement would be ample to provide a reasonable basis for a full search of all of the claims in the application. Applicant also traversed on the grounds that any search of even a single species of one or more of the "insecticides" of claims 13 - 18; of one or more of the "attractant" of claims 20 - 27; or of one or more of the "application method" of claims 44 - 47, would necessarily fold in the ambit of independent claim 1, and that any appropriate search of the subject matter of claim 1 should necessarily encompass those of claims 13 - 18, 20 - 27 and 44- 47 without requiring further restriction of the claims. The Examiner respectfully disagrees with this viewpoint. The species are independent or distinct because as disclosed the different species have mutually exclusive characteristics for each identified species. In addition, these species are not obvious variants of each other based on the current record. Further, there is an examination and search burden for these patentably distinct species due to their

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mutually exclusive characteristics. For these reasons, the restriction requirement is repeated and hereby expressly made **final**.

### ***Status of Claims***

Claims 1-59 are pending in the application. Claims 2-57 were amended in a preliminary amendment filed January 9, 2007. Claims 16-18, 22, 24-26 and 46-47 have been withdrawn as being directed to a non-elected invention. Claims **1-15, 19-21, 23, 27-45 and 48-59** are being examined for patentability.

### ***Priority***

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e), 119(a-d), or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. This application is a 371 of PCT/GB04/03658 filed on August 26, 2004.

### ***Information Disclosure Statement***

The Information Disclosure Statements (IDS) submitted on June 8, 2006 has been considered by the examiner.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1-15,19-21,23,27-45 and 48-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang et al. (US Patent 3,162,575) in view of Duffey et al. (3,826,232), Hagarty (US Patent 5,094,853), Emerson (US Patent 6,124,275) and Greene (US 4,473,582).**

***Applicant's Invention***

Applicant is claiming a solid stick insecticidal composition comprising a base, an insecticide and at least 60 wt% food materials, the composition having a penetration hardness of from 0.1 to 5mm.

***Determination of the scope and the content of the prior art  
(MPEP 2141.01)***

Lang et al. teach a method of controlling face flies on livestock comprising applying a composition that includes an insecticide that is admixed with a carrier material formed of a combination of microcrystalline wax (base material of instant application) and a medium viscosity oil (emulsifying agent of instant application). The composition is preferably formed into a solid elongated stick which is applied to the animals face by rubbing one end of the stick across the face of the animal. The insecticide bar also contains an attractant in combination with the insecticide and should

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include .25- 1.25% active ingredient, from 40-80% microcrystalline wax, 10-60% medium viscosity oil and 0 to 50% attractant (column 2, lines 15-25, 36-54 and 64-69).

***Ascertainment of the difference between the prior art and the claims  
(MPEP 2141.02)***

One difference between the invention of the instant application and that of Lang et al. is that Lang et al. do not expressly teach the use of 1 to 200 ppm (i.e., 0.0001-0.02%) human taste deterrent and a colorant. However, pesticidal compositions comprising 1 to 200 ppm (i.e., 0.0001-0.02%) human taste deterrent and a colorant were known in the prior art. For example, Duffey et al. teach a pest control composition in a solid stick that comprises coloring agent and a bitter tasting agent such as denatonium benzoate in an amount of 0.0-0.1% (see column 3, line 64 and column 4, lines 25-37).

Another difference between the invention of the instant application and that of Lang et al. is that Lang et al. do not expressly teach the use of chlorpyrifos as the active insecticidal agent and honey as the attractant used in a method of controlling cockroaches. However, pesticidal compositions comprising chlorpyrifos as that active insecticidal agent and honey as the attractant used in a method of controlling cockroaches was known in the prior art. For example, Hagarty teaches an arthropodically-active composition comprising honey (column 4, lines 40-52) and chlorpyrifos (column 5, line 46) which is used to control cockroaches.

A third difference between the invention of the instant application and that of Lang et al. is that Lang et al. do not expressly teach the use of 0.0001-10% preservative and 0.001-10% antioxidant. However, pesticidal compositions comprising 0.0001-10% preservative and 0.001-10% antioxidant was known in the prior art. For example, Emerson teaches a method for controlling a pest population such as cockroaches using a composition comprising 0.01-10% sorbic acid , propylparaben (preservative component), butylated hydroxyanisole and butylated hydroxytoluene (antioxidant component, column 8, lines 31-55).

A fourth difference between the invention of the instant application and that of Lang et al. is that Lang et al. do not expressly teach an insect control product comprising a solid stick insecticidal composition and a package (limitation of instant claims 50-56) and an application method which comprises drawing the stick along the hard surface (limitation of instant claims 44 and 45). However, insect control products comprising a solid stick insecticidal composition and a package wherein said solid stick is used in a method which comprises drawing the stick along the hard surface was known in the prior art. For example, Greene teaches an insecticidal package for applying a thin film of water-insoluble insecticide to a household surface including a container and insecticidal stick (abstract). The container has parallel side walls and an end opening, a cap means cooperating with the container walls to provide a sealed closure for the opening, and means for propelling the insecticidal stick through the opening for application to a solid surface (claim 2 of Greene). Greene teaches that while holding the insecticidal applicator, the insecticidal stick is rubbed against a solid



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surface to form a thin, uniform, transparent film of liquid solvent containing insecticide (column 2, lines 65-68). With regard to the "wrapping including a tear line or point of weakness at a location or one or more intervals along the length of the wrapping" and "the package or wrapping comprises a label", this is merely judicious selection of wrapping/packaging used to protect insecticidal stick formulation by one of ordinary skill in the art in the absence of evidence to the contrary.

***Finding of prima facie obviousness***

***Rationale and Motivation (MPEP 2142-2143)***

The teachings of Lang et al. and Duffey et al. are directed to solid stick insecticidal compositions. Therefore, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to combine the teachings Lang et al. and Duffey et al. to arrive at a solid stick insecticidal composition comprising 1 to 200 ppm (i.e., 0.0001-0.02%) human taste deterrent and a colorant. Duffey et al. teach that the advantage of having a bitter tasting ingredient is that it will tend to prevent any licking off of the composition by another animal and will also be a deterrent to tasting by children (column 4, lines 25-30). Further, Duffey et al. teach that coloring agents are conventional ingredients which are normally incorporated into pesticidal formulations (column 4, lines 33-37). One would have been motivated to make this combination in order to receive the expected benefit of having a solid stick insecticidal composition that

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has a deterrent to tasting by children as well as prevent any licking off of the composition by an animal. Therefore, given the state of the art as evidenced by the teachings of the cited references, and absent any evidence to the contrary, there would have been a reasonable expectation of success in combining the teachings of the cited references to form a solid stick insecticidal composition

The teachings of Lang et al. Hagarty are directed to insecticidal compositions. Therefore, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to combine the teachings Lang et al. and Hargarty to arrive at a solid stick insecticidal composition comprising honey and chlorpyrifos used in a method of controlling cockroaches. Hagarty teaches that that cockroaches are sweet-loving insects and are attracted to honey. Further, Hagarty teaches that chlorpyrifos is an insecticide that is well known in the art. One would have been motivated to make this combination in order to receive the expected benefit of having a solid stick insecticidal composition that specifically attracts cockroaches due to the presence of the honey component. Therefore, given the state of the art as evidenced by the teachings of the cited references, and absent any evidence to the contrary, there would have been a reasonable expectation of success in combining the teachings of the cited references to form a solid stick insecticidal composition.

The teachings of Lang et al. Emerson are directed to insecticidal compositions. Therefore, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to combine the teachings Lang et al. and Emerson to arrive at a solid stick insecticidal composition comprising preservatives and antioxidants used in

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a method of controlling cockroaches. Emerson teaches that an antioxidant (i.e., preservative) component can included in a pesticidal composition to increase product shelf life, inhibit decomposition of the active compound or improve the stability of the controlling effect when the composition is applied to hosts infested with the targeted pests (column 8, lines 31-36). One would have been motivated to make this combination in order to receive the expected benefit of having a solid stick insecticidal composition that has an extended shelf life, is not decomposed over time and is stable when applied to hosts infested with the targeted pests. Therefore, given the state of the art as evidenced by the teachings of the cited references, and absent any evidence to the contrary, there would have been a reasonable expectation of success in combining the teachings of the cited references to form a solid stick insecticidal composition.

The teachings of Lang et al. and Greene are directed to solid stick insecticidal compositions. Greene teaches that the insecticide stick applicator and method of the their invention is characterized by high effectiveness against crawling insects, such as *Blattella germanica* (German cockroach) and *Periplaneta americana* (American cockroach); long residual activity; ease and convenience of use; suitability for application to any surface; ease of accurate and exact placement; coverage of a large surface area with a uniform, thin, transparent film; and storage stability. One would have been motivated to make this combination in order to receive the expected benefit of having a solid stick insecticidal composition has storage stability as well as the other aforementioned advantages. Further, in view of *In re Kerkhoven*, 205 USPQ 1069

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(*C.C.P.A. 1980*), it is *prima facie* obvious to combine two or more compositions each of which is taught by prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in prior art, thus claims that requires no more than mixing together two conventional solid stick insecticidal compositions set forth *prima facie* obvious subject matter.

With regards to the limitations of instant claims **1, 39-43 and 57-59**, Lang et al. do not teach the claimed setting point, melting point or the penetration hardness of the instant claimed composition. However, Lang et al. do teach that microcrystalline wax has a melting point 155-165 degrees Fahrenheit (i.e., 68.3-78.3 degrees Celsius) and a penetration of 25 maximum at 77 degrees Fahrenheit, 45 maximum at 100 degrees Fahrenheit and 110 maximum at 110 degrees Fahrenheit (column 3, lines 15-33). Further, the U.S. Patent Office is not equipped with analytical instruments to test prior art compositions for the infinite number of ways that a subsequent applicant may present previously unmeasured characteristics. When as here, the prior art appears to contain the exact same ingredients and applicant's own disclosure supports the suitability of the prior art composition as the inventive composition component, the burden is properly shifted to applicant to show otherwise.

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In light of the forgoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the teachings of the cited references, especially in the absence of evidence to the contrary.

***Conclusion***

No claims are allowed.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR Only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Courtney Brown, whose telephone number is 571-270-3284. The examiner can normally be reached on Monday-Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Fereydoun Sajjadi can be reached on 571-272-3311. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Courtney A. Brown  
Patent Examiner  
Technology Center 1600  
Group Art Unit 1617

/JANET L. EPPS -SMITH/  
Primary Examiner, Art Unit 1633